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7590 KENYON & KENYON Suite 600 333 W. San Carlos Street San Jose, CA 95110-2711			EXAMINER MILLER, BRIAN E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XM WONG and ROCK TAO

Appeal 2008-1723
Application 09/741,684
Technology Center 2600

Decided: June 12, 2008

Before TERRY J. OWENS, JOSEPH F. RUGGIERO, and ANITA
PELLMAN GROSS, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 19-24. Claims 1-18 and 25-30 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to a suspension and slider assembly for a magnetic recording head in which a bonding substance is heated prior to being applied as a surface finishing material to a metal bonding pad of the suspension. A slider bonding pad, which initially has no bonding substance, is coupled to the suspension by the reflowing of the bonding substance on the suspension bonding pad, thereby coupling the suspension bonding pad to the slider bonding pad. Reuse of the suspension is enabled by removing the connection with the slider bonding pad with heat treatment. (Specification 3).

Claim 19 is illustrative of the invention and reads as follows:

19. A suspension comprising:

a suspension bonding pad for electrically bonding a magnetic head terminal, wherein said bonding pad includes a metal pad having a bonding substance applied as a surface finishing material, the surface finishing material being heat treated prior to bonding to a surface; and a slider bonding pad initially without bonding substance coupled to said suspension such that the bonding substance on said suspension bonding pad is reflowed so as to electrically couple the suspension bonding pad and the slider bonding pad, wherein the slider bonding pad enables the reuse of the suspension by removing the connection between a slider and the slider bonding pad with heat treatment.

The Examiner relies on the following prior art references to show unpatentability:

Ainslie	US 4,761,699	Aug. 2, 1988
Albrecht	US 5,821,494	Oct. 13, 1998

Claims 19-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Albrecht.

Claims 19-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ainslie.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either one of Albrecht or Ainslie alone.¹

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(b), does either one of Albrecht or Ainslie have a disclosure which anticipates the invention set forth in claims 19-23?
- (ii) Under 35 U.S.C § 103(a), with respect to appealed claim 24, would one of ordinary skill in the art at the time of the invention have found it obvious to modify either one of Albrecht or Ainslie to render the claimed invention unpatentable?

¹ As indicated at page 2 of the Answer, the Examiner has withdrawn the 35 U.S.C. § 112, second paragraph, rejection of claims 19-24.

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

With respect to the 35 U.S.C. § 102(b) rejection of independent claim 19 based on the teachings of either one of Albrecht or Ainslie, the Examiner initially indicates (Ans. 3-4) how the various limitations are read on the disclosure of Albrecht. In particular, the Examiner directs attention to the illustration in Figures 3 and 12A-12C of Albrecht as well as the accompanying description at column 10, lines 35-53 and column 11, lines 16-25 of Albrecht. With respect to Ainslie, the Examiner (Ans. 4) points to the slider/suspension assembly structure illustrated in Figures 4-6 of Ainslie.

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of either one of Albrecht or Ainslie so as to establish a *prima facie* case of anticipation. Appellants’ arguments (App. Br. 5-6; Reply Br. 2) focus on the contention that, in contrast to the claimed invention, neither Albrecht nor

Ainslie provides a disclosure of a slider bonding pad which enables reuse of a magnetic recording head suspension by removing the connection with the slider bonding pad by heat treatment.

We do not find Appellants' arguments to be persuasive in showing any error in the Examiner's finding (Ans. 6) that the claimed feature of removing the slider bonding pad connection with heat treatment is a process limitation which is entitled to no patentable weight in a claim directed to a product. In other words, it is the patentability of the final product *per se* which must be determined. *See In re Thorpe*, 777 F. 2d 695, 697 (Fed. Cir. 1985).

We find that the Examiner has provided a reasoned analysis for concluding that the final end product in both Albrecht and Ainslie, i.e., the suspension including the slider/suspension connection, will be the same or at least structurally equivalent to that claimed. As explained by the Examiner (Ans. 6), the slider/suspension structure in both Albrecht and Ainslie corresponds to the structure that is presently claimed regardless of whether the solder bonding pad connection is subsequently removed by heat treatment melting of the solder.

Further, we find to be unpersuasive Appellants' contention (Reply Br. 2) that appealed claim 19 cannot be treated as a product by process claim because there is no process set forth. Appellants' arguments to the contrary notwithstanding, the only distinction alleged by Appellants over the bonding pad structure described by both Albrecht and Ainslie is based on the claimed limitation directed to the removal of the solder bonding pad connection through heat treatment, i.e., a process limitation, which is entitled to no patentable weight in a claim drawn to the product.

In view of the above discussion, it is apparent that, based on the record before us, Appellants have not shown how their claimed or, in fact, disclosed slider/suspension bonding pad structure distinguishes over that described by both Albrecht and Ainslie. Appellants' alleged distinction is that the claimed bonding pad enables reuse of the suspension by removing the bonding connection. However, Appellants point to no particular structure of the bonding pad and, indeed, there is no particular structure disclosed which would function to enable reuse of the suspension. Indeed, any enabling of reuse of the suspension is not based on any structure but rather on the removal of the bonding pad solder connection by heating, i.e., a process limitation, not a structural limitation.

35 U.S.C. § 103(a) REJECTION

Dependent claim 24

We also sustain the Examiner's obviousness rejection of dependent claim 24. We find no error in the Examiner's line of reasoning (Ans. 5) establishing a basis for modifying the disclosures of either one of Albrecht or Ainslie to address the dimensional features of claim 24. Appellants (App. Br. 6) have made no separate arguments for patentability of claim 24 but, instead, have relied on arguments with respect to Albrecht and Ainslie made against the rejection of claims 19-23, which arguments we found to be unpersuasive as discussed *supra*.

CONCLUSION

In summary, we have sustained the Examiner's rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 19-24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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